

ESTTA Tracking number: **ESTTA701123**

Filing date: **10/08/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Firefly Distilling Company LLC		
Entity	Corporation	Citizenship	Delaware
Address	16775 Bears Bluff Road Wadmalaw Island, SC 29487 UNITED STATES		

Attorney information	Thomas M. Hadid Cooley LLP 1299 Pennsylvania Ave., NW Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, thadid@cooley.com, vbadolato@cooley.com, pwillsey@cooley.com Phone:6508497007		
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Applicant Information

Application No	86503734	Publication date	09/22/2015
Opposition Filing Date	10/08/2015	Opposition Period Ends	10/22/2015
Applicant	Gristmill Distillers, Inc. 44 Keene Knolls Way Keene, NY 12942 UNITED STATES		

Goods/Services Affected by Opposition


Class 033. First Use: 2014/10/01 First Use In Commerce: 2014/10/01 All goods and services in the class are opposed, namely: Bourbon Whiskey
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3656525	Application Date	02/25/2008
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	FIREFL		

Design Mark	
Description of Mark	The mark consists of the wording "FIREFLY" with a design of a firefly comprising the letter "Y".
Goods/Services	Class 033. First use: First Use: 2006/05/01 First Use In Commerce: 2006/05/01 Liquor

U.S. Registration No.	3665660	Application Date	04/28/2008
Registration Date	08/11/2009	Foreign Priority Date	NONE
Word Mark	FIREFLY SWEET TEA HAND CRAFTED SWEET TEA FLAVORED VODKA		
Design Mark			
Description of Mark	The mark comprises the word "FIREFLY" with a design of a circle, a Palmetto tree on a landscape, a crescent moon, a horizon with foliage, and images of fire flies.		
Goods/Services	Class 033. First use: First Use: 2008/04/14 First Use In Commerce: 2008/04/14 Liquor		

U.S. Registration No.	4354291	Application Date	04/21/2010
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Registration Date	06/18/2013	Foreign Priority Date	NONE
Word Mark	FIREFLY SKINNY TEA		
Design Mark			
Description of Mark	The mark consists of the wording "FIREFLY SKINNY TEA" with a design of a firefly comprising the letter "Y" in firefly. The design of several small star shapes trails the tail of the firefly suggesting a trail of light.		
Goods/Services	Class 033. First use: First Use: 2011/02/00 First Use In Commerce: 2011/02/00 Low-calorie, low-sugar, tea-flavored vodka		

U.S. Registration No.	4589509	Application Date	01/29/2013
Registration Date	08/19/2014	Foreign Priority Date	NONE
Word Mark	FIREFLY MOONSHINE LIGHT IT UP!		
Design Mark			
Description of Mark	The mark consists of the words "FIREFLYMOONSHINE LIGHT IT UP!" featuring a dotted line representing the trail of a firefly in flight and a stylized image of a firefly.		

Goods/Services	Class 033. First use: First Use: 2013/03/00 First Use In Commerce: 2013/03/00 distilled spirits
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U.S. Application No.	85834756	Application Date	01/29/2013
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	FIREFLY MOONSHINE LIGHT IT UP!
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Design Mark	
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Description of Mark	The mark consists of the words "FIREFLYMOONSHINE LIGHT IT UP!" featuring a dotted line representing the trail of a firefly in flight and a stylized image of a firefly; a beach cottage, a palmetto tree and a crescent moon.
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Goods/Services	Class 033. First use: First Use: 2013/03/00 First Use In Commerce: 2013/03/00 distilled spirits
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FIREFLY		
Goods/Services	whiskey		

Attachments	77405013#TMSN.png(bytes) 77459747#TMSN.png(bytes) 85019459#TMSN.png(bytes) 85834757#TMSN.png(bytes) 85834756#TMSN.png(bytes) Firefly NOO re BLACKFLY BOURBON.pdf(458848 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Thomas M. Hadid/
Name	Thomas M. Hadid
Date	10/08/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 86/503,734
For the Trademark BLACKFLY BOURBON
Published in the *Official Gazette* on September 22, 2015

FIREFLY DISTILLING COMPANY LLC,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
GRISTMILL DISTILLERS, INC.,)	
)	
Applicant.)	
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NOTICE OF OPPOSITION

Opposer Firefly Distilling Company LLC (“Firely”), a Delaware limited liability company having its principal place of business at 16775 Bears Bluff Road, Wadmalaw Island, South Carolina 29487, will be damaged by the issuance of a registration for the mark BLACKFLY BOURBON (the “Applicant’s Mark”), as applied for in Application Serial No. 86/503,734, filed on January 14, 2015, by Applicant Gristmill Distillers, Inc., a New York corporation with a mailing address of 44 Keene Knolls Way, Keene, New York 12942 (“Applicant”).

As grounds for opposition, Firefly alleges as follows.

1. Firefly markets and sells a number of different types and brands of alcoholic beverages and distilled spirits, including vodka and bourbon prepared cocktails. Firefly has marketed and sold alcoholic beverages in the United States for nearly a decade. Firefly owns the

following United States trademark registrations and application pertaining to its FIREFLY brand:

FIREFLY and Design (U.S. Reg. No. 3,656,525), issued on July 21, 2009, for “liquor”;

FIREFLY SWEET TEA HAND CREATED SWEET TEA FLAVORED VODKA

(U.S. Reg. No. 3,665,660), issued on August 11, 2009, for “liquor”;

FIREFLY SKINNY TEA (U.S. Reg. No. 4,354,291), issued on June 18, 2013, for “low-calorie, low-sugar, tea-flavored vodka”;

FIREFLY MOONSHINE LIGHT IT UP! (U.S. Reg. No. 4,589,509), issued on August 19, 2014, for “distilled spirits”; and,

FIREFLY MOONSHINE LIGHT IT UP! (U.S. Serial No. 85/834,756), filed on January 29, 2013 for “distilled spirits”

(collectively, Firefly’s “FIREFLY Marks”).

2. Since at least as early as 2006, Firefly has promoted and sold in commerce FIREFLY-branded alcoholic beverage products. In particular, since at least as early as April 2010, Firefly has continuously marketed and sold its FIREFLY-branded sweet tea whiskey, flavored with bourbon from the well-known Buffalo Trace Distillery, in interstate commerce. *See Exhibit A.* By virtue of its efforts and the excellence of the underlying products, the public has come to know, rely on, and recognize Firefly’s FIREFLY Marks as source identifiers for Firefly’s alcoholic beverage products. Firefly has gained valuable reputation and a substantial amount of goodwill through the use and recognition of its Marks.

3. On January 14, 2015, Applicant filed an application to register the mark BLACKFLY BOURBON on an intent-to-use basis in connection with “Bourbon whiskey.”

4. Firefly's FIREFLY Marks have priority through use in commerce and/or filing dates that predate Applicant's filing date of January 14, 2015.

5. The alcoholic beverage products offered under Applicant's Mark are likely to be confused with and mistaken for Firefly's alcoholic beverages marketed under its FIREFLY Marks because Applicant's Mark is similar to Firefly's FIREFLY Marks in sight, sound, meaning, and commercial impression.

6. Applicant's Mark is intended for use in connection with products that overlap with and are related to products Firefly offers under Firefly's FIREFLY Marks, namely alcoholic beverages and distilled spirits.

7. Applicant's targeted customer base overlaps with the consumers of Firefly's alcoholic beverages.

8. As the description of goods in the application for Applicant's Mark contains no restrictions or limitations as to Applicant's channels of trade, Firefly may assume that Applicant's Mark, like Firefly's FIREFLY Marks, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its alcohol-based products overlap with channels of trade used by Firefly in marketing, selling, and otherwise distributing its alcohol-based products marketed under Firefly's FIREFLY Marks.

9. If Applicant is permitted to register Applicant's Mark for the goods specified in the Application herein opposed, confusion resulting in damage and injury to Firefly would likely occur. Persons familiar with Firefly's FIREFLY Marks would likely perceive Applicant's products as associated or affiliated with or sponsored by Firefly when they are not.

10. Firefly's customers and the relevant public are likely to misapprehend Applicant's Mark as a Firefly mark rather than a mark of Applicant and/or believe in error that goods offered

under the Applicant's Mark are offered by, in association with, or under license from Firefly or Firefly.

11. Any defect, objection to, or fault found with Applicant's goods marketed under Applicant's BLACKFLY BOURBON mark would necessarily reflect on and injure the reputation that Firefly has established for its alcoholic beverage products.

12. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use Applicant's Mark, all to the detriment of Firefly.

13. Wherefore, Firefly prays that this Opposition be sustained and that Application Serial No. 86/503,734 be denied and refused registration.

COOLEY LLP

Date: October 8, 2015

By: /s/ Thomas M. Hadid
Peter J. Willsey, Esq.
Vincent J. Badolato, Esq.
Thomas M. Hadid, Esq.
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Washington, DC 20004
(650) 843-5000
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on October 8 2015, I mailed the foregoing NOTICE OF OPPOSITION regarding *Firefly Company, Inc. v. Gristmill Distillers, Inc.* to correspondent for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Mr. Luke Brean
BreanLaw, LLC
P.O. Box 4120 ECM #72065
Portland, OREGON 97208

Date: October 8, 2015

By: /s/ Thomas M. Hadid
Thomas M. Hadid

EXHIBIT A



(<http://www.bourbonblog.com/bourbon-tasting-hosting/>)



FIREFLY SWEET TEA BOURBON RELEASED BY FIREFLY DISTILLERY, SOUTH CAROLINA

Posted April 9, 2010 by Tom Fischer (<http://www.bourbonblog.com/author/tomfischer/>)



([http://www.bourbonblog.com/wp-](http://www.bourbonblog.com/wp-content/uploads/2010/04/firefly_sweet_tea_bourbon.jpg)

[content/uploads/2010/04/firefly_sweet_tea_bourbon.jpg](http://www.bourbonblog.com/wp-content/uploads/2010/04/firefly_sweet_tea_bourbon.jpg)) Wadmalaw Island, South Carolina's Firefly Distillery has unveiled the first ever sweet tea bourbon. Firefly Distillery Co-Founder Scott Newitt spoke with BourbonBlog.com (<http://BourbonBlog.com>) as he was boarding a plane to the Virgin Islands today.

"I love Bourbon. By no means is ours a high brow Bourbon," Newitt tells BourbonBlog.com (<http://bourbonblog.com/>). "It reminds me of the first Bourbons I ever drank when I was younger mixing Bourbon with sweet tea."

Made with handcrafted straight bourbon whiskey from Buffalo Trace Distillery in Frankfort, KY, Firefly Sweet Tea Bourbon is infused with authentic South Carolina tea and real Louisiana sugarcane. The result is the perfect blend of two Southern traditions.

Newitt says Firefly Sweet Tea Vodka has become available and popular in all 50 States and now Virgin Islands since they added this product to their line in 2008. Though it is evident that their products are most popular in their home state of South Carolina. Firefly has a joint venture with Buffalo Trace as half of Firefly's spirits are made at Buffalo Trace in Kentucky, and the other half being distilled in South Carolina and consumed by the state.

The popularity of Firefly Sweet Tea Vodka could be a sign that their Sweet Tea Bourbon will be very popular too. Sweet Tea Bourbon was released on April 1st in several states and is now trickling into the other States one by one.

After deciding to go forward with making a Firefly Sweet Tea Bourbon, the recipe and concept for it was perfected when Buffalo Trace's Lead Chemist Truman Cox came down to South Carolina to go deer hunting with one lead chemist Firefly Distillery Co-founder Jim Irvin. "What a way to work on making a Bourbon," says Newitt.

BourbonBlog.com (<http://bourbonblog.com/>) will bring you a review of Firefly's Sweet Tea Bourbon in the days to come.

Firefly Sweet Tea Bourbon, the sixth spirit from the Firefly family, is perhaps best enjoyed when mixed with spring water and served over ice. Share your own recipe, discover others and learn more at www.fireflyvodka.com (<http://www.fireflyvodka.com>). Firefly's famous slogan is, "Firefly – This ain't your Grandma's sweet tea!"

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Like this article? Here are some other articles of interest:

- **Firefly Sweet Tea Bourbon Review** (<http://www.bourbonblog.com/blog/2010/04/13/firefly-sweet-tea-bourbon-review-firefly-vodka-distillery/>)
- **Bourbon Cocktails from Peninsula Grill, Planters Inn, Charleston, South Carolina** (<http://www.bourbonblog.com/blog/2010/06/16/bourbon-cocktails-peninsula-grill-planters-inn-charleston-south-carolina/>)
- **National Iced Tea Day Recipe with Firefly Sweet Tea Vodka** (<http://www.bourbonblog.com/blog/2011/06/10/national-iced-tea-day-recipe-firefly-sweet-tea-vodka/>)
- **Firefly Distillery's Cocktails with a Cause** (<http://www.bourbonblog.com/blog/2010/11/23/firefly-distillerys-cocktails-with-a-cause/>)

TRACKBACKS/PINGBACKS

Firefly Sweet Tea Bourbon Review | BourbonBlog (<http://www.bourbonblog.com/blog/2010/04/13/firefly-sweet-tea-bourbon-review-firefly-vodka-distillery/>)
Firefly Distillery's Cocktails with a Cause | Best Alcohol (<http://www.bestalcohol.net/firefly-distillery%E2%80%99s-cocktails-with-a-cause/>)

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- Old Forester Birthday Bourbon 2015 Release at 100 Proof (<http://www.bourbonblog.com/blog/2015/09/12/old-forester-birthday-bourbon-2015-release-at-100-proof/>)
- 2015 Buffalo Trace Antique Collection (<http://www.bourbonblog.com/blog/2015/09/12/2015-buffalo-trace-antique-collection/>)
- California Bourbon and Whiskey? Yes, at Sonoma County Distilling Co. (<http://www.bourbonblog.com/blog/2015/09/12/sonoma-county-distilling-co-california-bourbon-and-whiskey/>)
- 5th Ever Kentucky State BBQ Festival in Danville Kentucky (<http://www.bourbonblog.com/blog/2015/09/12/5th-ever-kentucky-state-bbq-festival-danville-kentucky/>)
- Are there Whisk(e)y Sommeliers? Glad you asked... (<http://www.bourbonblog.com/blog/2015/08/31/whiskey-sommelier-whiskey-marketing-school-wizard-academy/>)
- Rum Old Fashioned (<http://www.bourbonblog.com/blog/2015/08/16/rum-old-fashioned/>)
- National Rum Day Cocktails (<http://www.bourbonblog.com/blog/2015/08/16/national-rum-day-cocktails/>)
- Saint James Cuvée 1765 Rum (<http://www.bourbonblog.com/blog/2015/08/16/saint-james-cuvee-1765-rum/>)
- Double Double Oaked Woodford Reserve (<http://www.bourbonblog.com/blog/2015/08/15/double-double-oaked-woodford-reserve/>)
- Woodford Reserve Sweet Mash Redux (<http://www.bourbonblog.com/blog/2015/08/15/woodford-reserve-sweet-mash-redux/>)
- A. Smith Bowman Distillery Releases Abraham Bowman Limited Edition High Rye Bourbon (<http://www.bourbonblog.com/blog/2015/08/13/a-smith-bowman-distillery-releases-abraham-bowman-limited-edition-high-rye-bourbon/>)
- More Stolen Bourbon and Pappy Van Winkle Recovered (<http://www.bourbonblog.com/blog/2015/08/13/more-stolen-bourbon-and-pappy-van-winkle-recovered/>)
- Yellowstone Bourbon Limited Edition 2015 (<http://www.bourbonblog.com/blog/2015/08/07/yellowstone-bourbon-limited-edition-2015/>)

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